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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,491	04/15/2004	Wayne Ernest Conrad	12811-401/PMdC	6576
1059	7590	02/06/2006	EXAMINER	
BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA			HOPKINS, ROBERT A	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,491

Applicant(s)

CONRAD ET AL.

Examiner

Robert A. Hopkins

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-39 is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-6-04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 33-39 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A filter which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Examiner notes claim 33 uses the negative limitations "wherein a filter is not positioned in the passage". Examiner notes however that claim 33 does not require a filter to be positioned anywhere within the canister or upright vacuum cleaner, which teaches against a critical element of the current application, namely a filter which is required for removing the particles which cannot be removed from the airflow by a first cyclone or a plurality of second cyclones. Examiner notes figures 2,3 and 5 of the current drawings all include a filter(50) within the vacuum cleaner. Examiner also notes figure 1, labeled as a prior art figure, does not include a filter within or downstream of the cyclone, therefore the filter is not deemed to be a conventional structure and therefore is critical or essential to the practice of the invention, and therefore should be included in claim 33. Examiner notes that the negative limitation may be retained in claim 33 only if a positive limitation equivalent to part(d) of claim 23 is included in claim 33. Examiner notes that such an incorporation would not constitute double patenting over claim 23, because claim 33 requires a passage extending from the first cyclonic stage to the second cyclonic stage, and claim

Art Unit: 1724

23 does not require a passage. Claims 34-39 depend on claim 33 and hence are also rejected.

Allowable Subject Matter

Claim 23-32 are allowed.

The following is an examiner's statement of reasons for allowance:

Claim 23 recites "a filter positioned downstream from the second cyclonic cleaning stage and in fluid flow communication with each downstream cyclone air exit". Davis(3425192) teaches a vacuum cleaning system including a filter(80) positioned downstream from a second cyclonic cleaning stage including a plurality of cyclones in parallel(52) and in fluid flow communication with each downstream cyclone air exit, however Davis teaches the vacuum cleaning system having an inlet(30) connected to a conventional suction tool, and therefore Davis does not teach or suggest a canister or upright vacuum cleaner, nor does Davis teach or suggest a vacuum cleaner head having a dirty air inlet as required by claim 1. Examiner notes the system of Davis is a large stationary system mounted upon a receptacle , wherein the system does not include a vacuum cleaner head. Oh(2005/0050863) teaches an upright vacuum cleaner having a vacuum cleaner head, first cyclonic stage, second cyclonic stage including a plurality of downstream cyclones. However Oh fails to teach or suggest a filter positioned downstream from the second cyclonic cleaning stage and in fluid flow communication with each downstream cyclone air exit. Also, the effective filing date of Oh is May 7, 2004, which does not predate the effective filing date of the parent

Art Unit: 1724

application 09/227,712 of the current application, the parent application having a filing date of 01/08/1999. Therefore, the Oh publication is not a proper 102(e) reference, and therefore could not be used in a 103 obviousness rejection with another reference.

Also, upon looking at the claims of the patents which resulted from the three applications in continuity with the current application, examiner determined that the current claims do not include limitations which would require a double patenting rejection. Examiner believes the closest claim language to claim 23 is claim 1 of US 6,238,451, however the claim of that patent recites that the filter is upstream of a second means for further cyclonically treating the dirty air stream, and is therefore not "positioned downstream from the second cyclonic cleaning stage" as required by claim 23 of the current application. Claims 24-32 depend on claim 23 and hence are also allowed.

Claims 33-39 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Claim 33 recites "a passage extending from the first cyclonic stage air exit to the second cyclonic stage air inlet wherein a filter is not positioned in the passage". Davis(3425192) teaches a vacuum cleaning system including a passage extending from a first cyclonic stage to a second cyclonic cleaning stage including a plurality of cyclones in parallel(52) and wherein a filter is not positioned in the passage, however Davis teaches the vacuum cleaning system having an inlet(30) connected to a conventional suction tool, and therefore Davis does not teach or suggest a canister or upright vacuum cleaner, nor does Davis teach or suggest a vacuum cleaner head

Art Unit: 1724

having a dirty air inlet as required by claim 1. Examiner notes the system of Davis is a large stationary system mounted upon a receptacle, wherein the system does not include a vacuum cleaner head. Oh(2005/0050863) teaches an upright vacuum cleaner having a vacuum cleaner head, first cyclonic stage, second cyclonic stage including a plurality of downstream cyclones, and a passage extending from the first cyclonic stage air exit to the second cyclonic stage air inlet wherein a filter is not positioned in the passage. However, the effective filing date of Oh is May 7, 2004, which does not predate the effective filing date of the parent application 09/227,712 of the current application, the parent application having a filing date of 01/08/1999. Therefore, the Oh publication is not a proper 102(e) reference, and therefore could not be used in a 102(e) anticipation rejection or a 103 obviousness rejection with another reference.

Also, upon looking at the claims of the patents which resulted from the three applications in continuity with the current application, examiner determined that the current claims do not include limitations which would require a double patenting rejection. Examiner believes the closest claim language to claim 23 is claim 1 of US 6,238,451, however the claim of that patent recites that the filter is upstream of a second means for further cyclonically treating the dirty air stream, and therefore a filter would be positioned in a passage extending from a first cyclonic stage to a second cyclonic stage. Claims 34-39 depend on claim 33 and hence would also be allowable upon correction of the 112 ist paragraph rejection.


Art Unit: 1724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Hopkins whose telephone number is 571-272-1159. The examiner can normally be reached on Monday-Friday, 7am-4pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rah
February 2, 2006


ROBERT A. HOPKINS
PRIMARY EXAMINER
A.U. 1724